

REMARKS

Upon entry of the amendments, claims 1-31 and 37-39 will be pending. Claims 1, 21-24, and 37-39 have been amended. Applicants submit that the amendments are supported in the specification and figures (e.g., Figs. 6, 8A-B, 11, 12) of the current application as originally filed and, therefore, no new matter has been added.

Applicants gratefully acknowledge the Examiner's indication in the Office action that claims 17-20 would be allowable if rewritten in independent form.

Rejections Under 35 U.S.C. §102/103

Claims 1-16, 21-31 and 37-39 have been rejected under 35 U.S.C. §102(e) as anticipated or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,409,504 to Jones *et al.* (hereinafter "Jones"). Applicants respectfully traverse.

Applicants initially point out that Jones is disqualified under 35 U.S.C. §103(c) as prior art in a rejection under 35 U.S.C. §103(a) against the claimed invention because the subject matter of Jones and the currently claimed subject matter were owned by the same entity or subject to a common obligation of assignment to the same entity at the time of the currently claimed invention. (See, e.g., MPEP § 706.02(I)). As set forth in the assignment recorded at reel/frame 010174/0725, right, title and interest in the subject matter disclosed in Jones has been assigned to "Align Technology, Inc.". Similarly, as set forth in the assignment recorded at reel/frame 013126/0358 for parent case U.S. Patent No. 7,040,896, right, title and interest in the subject matter of the current application has been assigned to "Align Technology, Inc."

Regarding the rejections under 35 U.S.C. §102(e), while Applicants do not agree with the rejections and do not acquiesce to any reasoning provided in the Office action, independent claims 1, 21-24, 37-39 have been amended herein to further clarify certain differences between the claimed invention and the cited art, and to further expedite prosecution of the current case. Claim 1, for example, has been amended to recite that inventive method includes defining a three dimensional closed cutting surface. As previously made of record, Jones teaches using 2-D slices of virtual dentition model to separate virtual teeth from the virtual

ELENA PAVLOVSKAIA *et al.*
Application No. 10/633,015
Reply to Office Action of August 6, 2008

PATENT

gingival, and would not appear to teach or suggest defining a 3-D closed cutting surface as specifically recited in the current claims.

Accordingly, for at least the reasons set forth above, Applicants respectfully request withdrawal of the rejections of claims 1-16, 21-31 and 37-39 under 35 U.S.C. §102(e) as anticipated or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over .

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

Date: 10/31/2008

By: 

Michael T. Rosato
Reg. No. 52,182

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 206-467-9600
Fax: 415-576-0300
MTR:mam
61509485 v1